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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,926	10/20/2005	Daniel Michael Doultou	5035-222US/P32,003 USA	6148
20802 7590 12/13/2007 SYNNESTVEDT LECHNER & WOODBRIDGE LLP P O BOX 592 112 NASSAU STREET PRINCETON, NJ 08542-0592			EXAMINER NGUYEN, KHAI MINH	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553.926

Applicant(s)

DOULTON, DANIEL MICHAEL

Examiner

Khai M. Nguyen

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/12/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement filed on 6/12/2006 and 9/15/2005 have been considered by the examiner (see attached PTO-1449 form or PTO/SB/08A and 08B forms).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/554022. Although the conflicting claims are not identical, they are not patentably distinct from each other because: all the claimed limitations of present Application Serial No. 10/553926 are transparently found in Application No. 10/554022 with obvious wording variation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-2 and 4-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gress et al. (U.S.Pub-20060128409) in view of McLaughlin et al. (U.S.Pub-20060058049).

Regarding claim 1, Gress teaches a method of providing voicemail to a mobile telephone, in which a caller initiates a voice call to the mobile telephone, but that call is diverted to a voicemail server, with the caller then leaving a voice message on the voicemail server; the method comprising the steps of:

(a) converting the voice message to an audio file (not show) format ([0025]-[0027]);

(b) sending or streaming the audio file (not show) over a wide area network to a voice to text transcription system comprising a network of computers ([0012]-[0014]);

(c) one of the networked computers playing back the voice message to an operator ([0012]-[0014]);

(d) the operator intelligently transcribing the original voice message into the computer to generate a transcribed SMS or MMS text message ([0012]-[0014]);

(e) the operator causing the transcribed SMS or MMS text message to be sent to the mobile telephone ([0012]-[0014]);

(f) sending the SMS or MMS text message to the mobile telephone ([0025]-[0027]).

Gress fails to specifically disclose audio file. However, McLaughlin teaches audio file ([0209]-[0212]). Therefore, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to apply the teaching of McLaughlin to Gress to provide textual communication and call transferring between nodes.

Regarding claim 2, McLaughlin and Gress further teach the method of claim 1 in which the transcribed text message includes a unique identification that links the text message to the voice message held at the voicemail server (see Gress, [0012]-[0014]) to allow that voice message to be played back to the wireless information device by an end-user selecting an option displayed on the device that relates to the transcribed text message (see McLaughlin, [0209]-[0212]).

Regarding claim 4, McLaughlin and Gress further teach the method of claim 1 in which the voice message is originated at a mobile telephone or at a landline telephone (see Gress, fig.1, wireless SMS devices 12, [0020]).

Regarding claim 5, McLaughlin and Gress further teach the method of claim 1 in which the transcribed text message has added to it caller identification data, such as a telephone number or caller name (see Gress, [0005], [0029]-[0030]).

Regarding claim 6, McLaughlin and Gress further teach the method of claim 5 in which the transcribed text message is displayed on the device as though it was sent directly from an originator of the voice message (see Gress, [0012]-[0014]).

Regarding claim 7, McLaughlin and Gress further teach the method of claim 3 in which the computer does not display to the operator the telephone number associated with the wireless information device (see Gress, [0012]-[0014]).

Regarding claim 8, McLaughlin and Gress further teach the method of claim 1 in which the computer displays to the operator an option to re-route the audio file (see McLaughlin, [0209]-[0212]) to a different computer with an operator that is more suited to transcribing the voice message because of linguistic, dialect, or cultural reasons (see Gress, [0012]-[0014]).

Regarding claim 9, McLaughlin and Gress further teach the method of claim 1 in which the computer provides the operator with a searchable list of specialised terms that are relevant to cultural sayings, regular events, sporting events, media events, other kinds of newsworthy events to assist the operator in accurately transcribing those specialised terms (see Gress, [0012]-[0014]).

Regarding claim 10, McLaughlin and Gress further teach the method of claim 1 in which the operator represents the mood of the caller leaving the voice message in the transcribed text message using either a written description or an emoticon (see Gress, [0014], [0020]-[0021]).

Regarding claim 11, McLaughlin and Gress further teach the method of claim 1 in which the operator succinctly summarises the voice message (see Gress, [0014], [0020]-[0021]).

Regarding claim 12, McLaughlin and Gress further teach the method of claim 10 in which the operator summarises the voice message to fit the 160 character SMS limit or concatenated text messages (see Gress, [0014], [0020]-[0021]).

Regarding claim 13, McLaughlin and Gress further teach the method of claim 1 in which the operator omits from the transcribed text message any hesitations, artefacts, or repetitions present in the voice message (see Gress, [0014], [0020]-[0021]).

Regarding claim 14, McLaughlin and Gress further teach the method of claim 1 in which the text message is sent to the wireless information device in a format previously specified as appropriate by the user of the device (see Gress, [0012]-[0014], [0029]-[0030]).

Regarding claim 15, McLaughlin and Gress further teach the method of claim 1 in which the text message is sent as an SMS, MMS, e-mail or fax (see Gress, [0029]-[0030]).

Regarding claim 16, McLaughlin and Gress further teach the method of claim 1 comprising the further step of parsing the transcribed text message and using the parsed data in an application running on the wireless information device (see Gress, [0012]-[0014], [0029]-[0030]).

Regarding claim 17, McLaughlin and Gress further teach the method of claim 16 in which parsing and using the parsed data involves one or more of the following:

(a) extracting the phone number spoken allowing it to be used (to make a call), saved, edited or added to a phone book (see Gress, [0012]-[0014]);

(b) extracting an email address and allowing it to be used, saved, edited or added to an address book (see Gress, [0012]-[0014]);

(c) extracting a physical address and allowing it to be used, saved, edited or added to an address book (see Gress, [0012]-[0014]);

(d) extracting a web address (hyperlink) and allow it to be used, edited, saved or added to an address book or browser favourites (see Gress, [0012]-[0014]);

(e) extracting a time for a meeting and allow it to be used, saved, edited and added to an agenda as an entry (see Gress, [0012]-[0014]);

(f) extracting a number and saving it to one of the device applications (see Gress, [0012]-[0014]);

(g) extracting a real noun and providing options to search for it or, look it up on the web (WAP or full browser) (see Gress, [0014], [0020]-[0021]).

Regarding claim 18, McLaughlin and Gress further teach the method of claim 1 in which if the recording time of a voice message is less than a user set maximum time, then the message is transcribed (see Gress, [0032], see McLaughlin, [0018]-[0019]), otherwise, it is not transcribed but instead a standard notification is sent to the user that they have a new voicemail to listen to (see Gress, [0032]-[0036]).

Regarding claim 19, McLaughlin and Gress further teach the method of claim 18 in which a human transcriber listens to the voice message(see McLaughlin, [0209]-[0212]) and writes up a very short indication of the subject of the call which is sent to the message recipient (see Gress, [0032]-[0036]).

Regarding claim 20, McLaughlin and Gress further teach the method of claim 18 in which, for devices that support less than a certain amount of text, there is an initial Look up of the text limitations in a database and then an automatic suggestion of appropriate maximum recording time (see Gress, [0032]-[0036]).

Regarding claim 21, McLaughlin and Gress further teach a text message which has been transcribed from a voicemail and is provided to a wireless information device using the method of claim 1 (see Gress, [0012]-[0014]).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gress et al. (U.S.Pub-20060128409) in view of McLaughlin et al. (U.S.Pub-20060058049), and further in view of Martin (U.S.Pat-6606373).

Regarding claim 3, McLaughlin and Gress further teach the method of claim 1,

However, McLaughlin and Gress fail to specifically disclose audio file the transcribed text message has added to it the time and date that the voice message was originally received at the voice mail server. However, Martin teaches the transcribed text message has added to it the time and date that the voice message was originally received at the voice mail server ([0209]-[0212]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of Martin to McLaughlin and Gress to covert voice message to text message, and transmitting a text message to a mobile.

Conclusion


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khai M. Nguyen whose telephone number is 571.272.7923. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571.272.7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Khai Nguyen
Au: 2617

12/6/2007


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SUPERVISORY PATENT EXAMINER